



08-09-05

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ASMEX.282A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Zhimin Lu
Appl. No. : 09/870,393
Filed : May 29, 2001
For : METHOD AND APPARATUS TO
CORRECT WAFER DRIFT
Examiner : Evan T. Pert
Group Art Unit : 2826

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being sent via Express Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

August 8, 2005

(Date)

Nira M. Brand
Nira M. Brand, Reg. No. 52,648

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. 1.705(b)

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This petition is filed under 37 C.F.R. § 1.705(b), requesting reconsideration of the patent term adjustment, and is submitted after the mailing date of the notice of allowability and upon payment of the issue fee for the above-identified patent. The fee set forth in 37 C.F.R. § 1.18(e) is enclosed.

Applicant submits that the patent term adjustment of 0 days provided on Form PTOL-85 with the Notice of Allowability has been erroneously calculated, based on an incorrect date assigned to the Patent Term Adjustment History listings for "Statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant" and "Payment of additional filing fee." Applicant hereby petitions for the recalculation of the patent term adjustment. As explained below, the correct patent term adjustment is 845 days. The relevant prosecution history, as well as the bases for Applicant's arguments under Rules 1.703(a) and 1.703(f), are set forth below.

STATEMENT OF FACTS

In accordance with §1.705(a)(2)(i), Applicant submits that the correct patent term adjustment is 817 days. A copy of the Patent Term Adjustment History of the present application from the USPTO website is attached.

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Filed : **May 29, 2001**

The PTO correctly assigned a patent term adjustment of 899 days under §1.702 (a)(1) for failure to mail a notification under 35 U.S.C. 132 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a).

However, the Patent Term Adjustment History incorrectly lists a delay of 900 days on the part of the Applicant associated with filing of “a statement by one or more inventors satisfying the requirements under 35 UCS 115, Oath of the Application” and “payment of additional filing fee.” Applicant actually mailed these documents on December 21, 2001, and the documents were acknowledged as received by the PTO on January 23, 2002. A copy of the date-stamped return postcard showing receipt of these documents is enclosed.

However, the Postal Service also delayed in delivering the “statement” and “payment.” The mailing occurred during the period when anthrax was suspected in the U.S. mail. In the ordinary course, the mailing would be expected to be received within three business days. In light of the intervening holiday, the mailing should have been received on December 26, 2001, rather than the January 23, 2002 date acknowledged by the PTO.

Thus, although the Patent Term Adjustment History indicates a delay of 900 days on the part of the Applicant for submitting the documents requested in the Notice to File Missing Parts, these documents were, in fact, received by the PTO on January 23, 2002, which was 82 days more than three months after mailing of the Notice to File Missing Parts, and should have been received by December 26, 2001, which was only 54 days more than three months after mailing of the Notice to File Missing Parts.

In accordance with the above-listed bases of calculation, Applicant asserts that the correct patent term adjustment due to this patent is 845 days ($899-54 = 845$).

In accordance with §1.705(a)(2)(ii), the relevant dates as specified in §§1.703(a) through (e) for which adjustment is sought are as follows:

On **May 29, 2001**, the application was filed. A return receipt postcard from the PTO, dated-stamped May 29, 2001, was received, assigning the application Serial No. 09/870,393.

On **August 2, 2001** a Notice to File Missing Parts was mailed to the Applicant. This Notice was never received.

On **December 21, 2001**, having still not received the Notice to File Missing Parts, the Applicant voluntarily submitted the documents expected to be requested in the Notice to File Missing Parts together with a Request for Entry of Declaration and the applicable fee. The

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Filed : **May 29, 2001**

documents were sent with a First Class Mail certification, and the return receipt postcard from the PTO, dated-stamped **January 23, 2002**, was received for this submission.

On **January 13, 2005**, Applicant received a first action under 35 U.S.C. 132. This date is 899 days later than 14 months from the assigned filing date, and, thus, the period of adjustment under § 1.703(a) is 899 days.

In accordance with §1.705(a)(2)(iii), Applicant submits that the patent is not subject to a terminal disclaimer.

In accordance with §1.705(a)(2)(iv), Applicant submits that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in §1.704, as evidenced by the following facts and relevant dates:

On **May 29, 2001**, the application was filed. A return receipt postcard from the PTO, dated-stamped May 29, 2001, was received, assigning the application Serial No. 09/870,393.

On **October 1, 2001**, the Applicant submitted a first Information Disclosure Statement to the Patent Office. A return receipt postcard from the PTO, dated-stamped October 4, 2001, was received for this submission.

According to an Attorney's Memo to our file, on **December 6, 2001**, Applicant's attorney telephoned the Customer Service Branch of the PTO to inquire why no Notice to File Missing Parts for the application had been received. The PTO representative stated that a Notice to File Missing Parts had been sent out on August 2, 2001 and that the supervisor on the case would call the attorney. No such call was ever received.

On **December 21, 2001**, the Applicant voluntarily submitted the documents requested in the Notice to File Missing Parts together with a Request for Entry of Declaration and the applicable fee, since no Notice to File Missing Parts had yet been received. A return receipt postcard from the PTO, dated-stamped January 23, 2002, was received for this submission.

On **August 2, 2002**, a Preliminary Amendment was filed. A return receipt postcard from the PTO, dated-stamped August 6, 2002, was received for this submission.

On **November 26, 2002**, Applicant's attorney sent a first Status Check letter to the PTO, inquiring about the application. Additional Status Check letters were sent to the PTO on **May 23, 2003** and **November 21, 2003**.

On **April 20, 2004**, Applicant's attorney had a phone conversation with a Ms. McDowell of the PTO, and subsequently faxed Ms. McDowell copies of all Missing Parts documents that

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Filed : May 29, 2001

had been submitted in December 2001, along with a copy of the January 23, 2002 postcard confirming receipt of the documents at the PTO. Thus, the April 20, 2004 date listed in the online Patent Term Adjustment History constitutes the date upon which the PTO received faxed copies of the documents that it had previously acknowledged as having been received on January 23, 2002.

On **April 21, 2004**, Ms. McDowell faxed a copy of the Notice to File Missing Parts to the Applicant's attorney.

On **April 29, 2004**, Applicant received a filing receipt for the application from the PTO, assigning the filing date of May 29, 2001.

Applicant submits that the above-listed facts provide evidence that, given the circumstances of the case, Applicant was diligent in and engaged in reasonable efforts to conclude processing or examination of the application.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the correct patent term adjustment for the above-identified patent should be 845 days.

The undersigned has made a good faith effort to set forth all relevant facts and bases for adjustment involved. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call the undersigned to discuss such issues.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Aug 8, 2005

By: Nira Brand

Nira Brand

Registration No. 52,648

Agent of Record

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Patent Scientist

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

Attorney Docket No. : ASMEX.282A
Applicant(s) : Zhimin Lu
For : METHOD AND APPARATUS TO CORRECT
WAFER DRIFT
Agent : Nira Brand
"Express Mail" Label No. : EV 309180435 US
Date of Deposit : August 8, 2005

I hereby certify that the accompanying

Request for Reconsideration of Patent Term Adjustment; Check for Filing Fee;
Return Prepaid Postcard

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and are addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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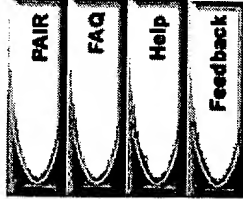
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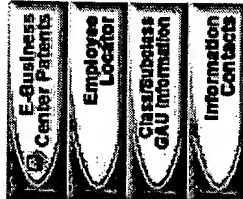
United States Patent and Trademark Office

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PATENT APPLICATION INFORMATION RETRIEVAL



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Printer Friendly Version

| Patent Term Adjustment (PTA) for application number: 09/870,393 | | | |
|---|------------|-----------------------------|-----|
| Filing or 371(c) Date: | 05-29-2001 | USPTO Delay (PTO): | 899 |
| Issue Date of Patent: | - | Three Years: | - |
| Pre-Issue Petitions (days): | +0 | Applicant Delay (APPL): | 900 |
| Post-Issue Petitions (days): | +0 | Total PTA: | 0 |
| USPTO Adjustment (days): | +0 | Explanation of Calculations | |

Select Search Option

Assignments

Continuity Data

Display References

File History

Image File Wrapper

Publication Review

Search

Patent Term Adjustment History

| Date | Contents Description | PTO (days) | APPL (days) |
|------------|---|------------|-------------|
| 05-09-2005 | Mail Notice of Allowance | | |
| 05-03-2005 | Issue Revision Completed | | |
| 05-03-2005 | Notice of Allowance Data Verification Completed | | |
| 05-03-2005 | Case Docketed to Examiner in GAU | | |
| 05-03-2005 | Notice of Allowability | | |
| 02-25-2005 | Date Forwarded to Examiner | | |
| 02-15-2005 | Response to Election / Restriction Filed | | |
| 02-15-2005 | Workflow incoming amendment IFW | | |
| 01-25-2005 | Case Docketed to Examiner in GAU | | |
| 01-13-2005 | Mail Restriction Requirement | 899 | |
| 01-10-2005 | Requirement for Restriction / Election | | |

| | | |
|------------|---|-----|
| 11-12-2004 | Case Docketed to Examiner in GAU | ↑ |
| 10-21-2004 | Transfer Inquiry to GAU | ↑ |
| 08-25-2004 | Case Docketed to Examiner in GAU | ↑ |
| 06-25-2004 | IFW TSS Processing by Tech Center Complete | ↑ |
| 06-25-2004 | Claims PTO | ↑ |
| 09-25-2003 | Information Disclosure Statement (IDS) Filed | ↑ |
| 08-06-2002 | Preliminary Amendment | ↑ |
| 01-08-2002 | Reference capture on IDS | ↑ |
| 01-08-2002 | Information Disclosure Statement (IDS) Filed | ↑ |
| 10-04-2001 | Reference capture on IDS | ↑ |
| 10-04-2001 | Information Disclosure Statement (IDS) Filed | ↑ |
| 06-25-2004 | Case Docketed to Examiner in GAU | ↑ |
| 06-24-2004 | Case Docketed to Examiner in GAU | ↑ |
| 04-28-2004 | Application Dispatched from OIPE | ↑ |
| 04-29-2004 | Application Is Now Complete | ↑ |
| 04-20-2004 | Payment of additional filing fee/Preexam | 900 |
| 04-20-2004 | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant | ↑ |
| 08-02-2001 | Notice Mailed--Application Incomplete--Filing Date Assigned | ↑ |
| 08-02-2001 | Correspondence Address Change | ↑ |
| 06-07-2001 | IFW Scan & PACR Auto Security Review | ↑ |
| 05-29-2001 | Initial Exam Team nn | ↑ |

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UTILITY/DESIGN PATENT

(Missing Parts)

DATE OF C.A.: 8/2/01

DATE: 12/21/01

Rec'd in the U.S.P.T.O. on the date stamped hereon via Certificate of Mail:

Atty. Dkt. # ASMEX.282A

A/N: 09/870,393

Filed: 5/29/01

Applicant: Lu

Atty: ASA

Title: Method and Apparatus To Correct Writer Drift

VERIFIED BY: Asst: JP

Quality Control:

☒ Transmittal Letter in Duplicate

☐ Preliminary Amendment in pgs.

☐ Copy of Notice of Missing Requirements

☐ Copy of Original Specification and Drawings

☒ Decl. and Power of Attorney

☐ Decl. by Inventor(s)

☒ Power of Atty. by Assignee; Copy of Assignment

☐ Ext. of Time Requested

☐ Small Entity Statement(s)

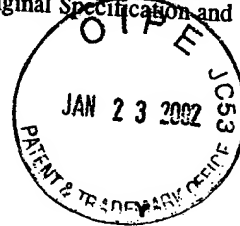
☐ Letter Requesting Refund in dupl.

☒ \$ 1404 Check for Filing Fee

☐ Information Disclosure Statement; PTO 1449 w/ Ref(s).

☒ Request for Entry of Declaration

☒ Return Postcard



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Best Available Copy